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EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
08/864,762

Applicant(s)  
Tomita

Examiner  
John Young

Art Unit  
3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 17, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-26, 28, 29, 50, 52, 53, and 65-77 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-26, 28, 29, 50, 52, 53, and 65-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**FINAL ACTION REJECTION BASED ON (RCE)**

**(PAPER 50)**

1. **Claims 17, 18, 30, 32-35 & 37 are canceled by Applicant (Amendment J, paper#49 filed 3/17/2003).**
2. **Claims 24-26, 28, 50, 52 & 65-67 are amended (Amendment J).**
3. **Claims 24-26, 28-29, 50, 52, 53 & 65-77 are pending.**

**DRAWINGS**

4. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes.

**CLAIM REJECTIONS — 35 U.S.C. §112 ¶2**

5. **Rejections Withdrawn.** (Claims 17 & 30 are canceled by Applicant).

**CLAIM REJECTIONS - 35 U.S.C. §103(a)**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Independent claim 24 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schultz 5,056,019(10/8/1991) (herein referred to as "Schultz") in view of Humble 4,949,256

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(8/14/1990) (herein referred to as "Humble") and further in view of Small 4,815,741 (03/28/1989) (herein referred to as "Small").

As per claim 24, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, 11. 6-11; col. 1, 11. 15-16; col. 6, 11. 5-10; col. 5, 11. 12-15; col. 5, 11. 47-53; col. 5, 11. 57-68; col. 6, 11. 1-4; and col. 6, 11. 10-12) shows a "point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . ."

Schultz (col. 6, 11. 6-10; col. 4, 11. 56-60; col. 5, 11. 15-20; col. 8, 11. 45-55; col. 8, 11. 64-65; and col. 10, 11. 46-50 ) shows "point issue means for issuing the points to the customer according to transactions performed by the customer . . ."

Schultz (col. 7, 11. 25-27) discloses "*accumulating sales data . . .* The Examiner interprets this disclosure as suggesting "point accumulation means. . . ."

Schultz (col. 10, 11. 7-15; col. 10, 11. 20-27; col. 10, 11. 36-39; col. 10, 11. 46-50; col. 9, 11. 25-33; col. 8, 11. 48-65; col. 7, 11. 25-27; col. 7, 11. 35-44; col. 8, 11. 1-6; and col. 5, 11. 45-53) shows elements that suggest "point accumulation means for calculating and accumulating the issued points. . . ."

Schultz (col. 6, 11. 28-36; col. 6, 11. 39-52; col. 7, 11. 5-10; and col. 10, 11. 1-13) shows "customer identification means for identifying the customer according to customer identification information. . . ."

Schultz lacks explicit mention of "condition monitor means for changing the accumulated points according to predetermined conditions . . . wherein the condition

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monitor means adds interest to the customer's points according to the accumulated points and periods of time."

Humble (the FIGURE; col. 3,11. 67-68; and col. 6,11. 48-55) shows "condition monitor means for changing the accumulated points according to predetermined conditions. . . . wherein the condition monitor means adds interest to the customer's points according to the accumulated points and periods of time."

Humble proposes "condition monitor" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "condition monitor" modifications of Humble with the teachings of Schultz because such condition monitor means would have provided a *"validation network for automatically crediting customer's coupons toward the purchase price of a plurality of products . . . (See Humble (col. 2, 11. 66-68)).*

Schultz lacks an explicit recitation of "the customer accesses the accumulated points stored on the computer through a terminal."

Small (FIG. 7 through FIG. 10; col. 1,11. 13-26; col. 1,11. 33-42; col. 6,11. 48-55; col. 9,11. 38-44; col. 9,11. 53-56; col. 10,11. 4-15; col. 11,11. 3-9; col. 11, 11. 16-21; col. 11, 11. 62-63; and col. 12,11. 33-40) shows: "the customer accesses the accumulated points stored on the computer through a terminal."

Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a

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means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, 11. 30-40)).

It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Schultz (col. 10,11. 43-53) discloses: *"manufacturers . . . can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer *"interest."*

Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets this disclosure as reasonably suggesting *"a software service in exchange for an amount of the accumulated points. . . ."*

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."* The Examiner interprets this disclosure as reasonably

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suggesting "a period of time of providing the software service. . . ."; furthermore,

The Examiner interprets the above disclosures as reasonably suggesting "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that

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**"the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).**

**Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of**



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**time of providing the software service. . . . " because such a marketing program would have encouraged "*continued purchases of targeted products beyond the one-time incentive of prior coupon systems. "* (See Schultz (col. 4,11.45-47)).**

7. Independent claim 25 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schultz in view of Humble and Burton and further in view of Small.

As per claim 25, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a "point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows "point issue means for issuing the points to the customer according to transactions performed by the customer. . . ."

Schultz (col. 7, ll. 25-27) discloses "*accumulating sales data. . . .*" The Examiner interprets this disclosure as suggesting "point accumulation means. . . ."

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows "point accumulation means for calculating and accumulating the issued points. . . ."

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows "point accumulation means for calculating and accumulating the issued points. . . ."

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Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows “customer identification means for identifying the customer according to customer identification information. . . .”

Schultz lacks explicit mention of “condition monitor means for changing the accumulated points according to predetermined conditions. . . . wherein the condition monitor means decreases the customer’s points if the customer does not carry out a transaction during a predetermined period.”

Humble (the FIGURE; col. 3, ll. 67-68; and col. 6, ll. 48-55) shows elements that suggest “condition monitor means for changing the accumulated points according to predetermined conditions. . . .”

Humble proposes “condition monitor” modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “condition monitor” modifications of

Humble with the teachings of Schultz because such condition monitor means would have provided a “*validation network for automatically crediting customer’s coupons toward the purchase price of a plurality of products. . . .*” (See Humble (col. 2, ll. 66-68)).

Burton (FIG. 2.8A; FIG. 2.8B; col. 9, ll. 50-68; col. 10, ll. 1-7; col. 10, ll. 44-51; col. 28, ll. 16-35; and col. 28, ll. 60-68) shows elements that suggest “wherein the condition monitor means decreases the customer’s points if the customer does not carry out a transaction during a predetermined period.”

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Burton proposes credit decreasing modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the credit decreasing modifications of

Burton with the teachings of Schultz because “*the participants can choose to withhold none, part, or all of the monetary amount eligible for allocation toward the credit. . . .*” (See Burton (col. 4, ll.16-19)).

Schultz lacks an explicit recitation of “the customer accesses the accumulated points stored on the computer through a terminal.”

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; and col. 12, ll. 33-40) shows elements that impliedly suggest: “the customer accesses the accumulated points stored on the computer through a terminal.”

Small proposes “terminal notification” modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “terminal notification” modifications of Small with the teachings of Schultz because such modifications would have provided a means to “*Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . .*” (See Small (col. 2, ll. 30-40)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including**

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non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Schultz (col. 10,11. 43-53) discloses: *"manufacturers ... can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer *"interest."*

Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets this disclosure as reasonably suggesting *"a software service in exchange for an amount of the accumulated points. . . ."*

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."* The Examiner interprets this disclosure as reasonably suggesting *"a period of time of providing the software service. . . ."*; furthermore, The Examiner interprets the above disclosures as reasonably suggesting *"wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the*

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customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

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Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." because such a marketing program would have encouraged *"continued purchases of targeted products beyond the one-time incentive of prior coupon systems. "* (See Schultz (col. 4,11.45-47)).

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8. Independent claims 26, 65-77 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schultz and further in view of Small.

As per claim 26, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a “point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows “point issue means for issuing the points to the customer according to transactions performed by the customer. . . .”

Schultz (col. 7, ll. 25-27) discloses “*accumulating sales data. . . .*” The Examiner interprets this disclosure as suggesting “point accumulation means. . . .”

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows “point accumulation means for calculating and accumulating the issued points. . . .”

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows “customer identification means for identifying the customer according to customer identification information. . . .”

Schultz (col. 4, ll. 60-61; and col. 5, ll. 9-10) discloses “*participating retail outlets. . . .*”

Schultz (col. 5, ll. 53-56) discloses “*Each retail outlet . . . may be part of a retail*

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*chain, and the method of the present invention can be adapted for use at retail outlets . . . of different retail chains.”*

Schultz (col. 7, ll. 53-59) discloses “*the marketing program can be provided to consumers . . . through a plurality of retail stores associated with different retail chains. In the preferred embodiment, the consumer . . . is able to make reward product . . .*

*purchases at more than one retail store . . . and have the purchase credits combined in the PMCS. . . .*” The Examiner interprets these disclosures as suggesting “wherein the point accumulation means includes means for converting the customer’s points managed by a group of stores into points managed by another group of stores according to a predetermined rate if the customer requests the conversion.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 7, ll. 53-59; col. 5, ll. 45-56; and col. 6, ll. 1-13) would have been selected in accordance with “wherein the point accumulation means includes means for converting the customer’s points managed by a group of stores into points managed by another group of stores according to a predetermined rate if the customer requests the conversion. . . .” because such selection would have provided means for the “*consumer . . . to make reward product . . . purchases at more than one retail store . . . and have the purchase credits combined. . . .*” (See Schultz (col. 7, ll. 53-59)).

Schultz lacks an explicit recitation of “the customer accesses the accumulated points stored on the computer through a terminal.”



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Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; and col. 12, ll. 33-40) shows elements that suggest: "the customer accesses the accumulated points stored on the computer through a terminal."

Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).**

Schultz (col. 10,11. 43-53) discloses: *"manufacturers ... can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer *"interest."*

Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products*

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*and a reward certificate for the rewards earned.” The Examiner interprets this disclosure as reasonably suggesting “a software service in exchange for an amount of the accumulated points. . . .”*

Schultz (col. 9,11.13-25) discloses: *“Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . .”* The Examiner interprets this disclosure as reasonably suggesting “a period of time of providing the software service. . . .”; furthermore,

The Examiner interprets the above disclosures as reasonably suggesting “wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . .”

Schultz lacks an explicit recitation of “wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . .” even though

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Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)). And

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**it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." because such a marketing program would have encouraged "*continued purchases of targeted products beyond the one-time incentive of prior coupon systems.* " (See Schultz (col. 4,11.45-47)).**

As per claim 65 Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a "point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows "point issue means for issuing the points to the customer according to transactions performed by the customer. . . ."

Schultz (col. 7, ll. 25-27) discloses "*accumulating sales data. . . .*" The Examiner interprets this disclosure as suggesting "point accumulation means. . . ."

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Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows “point accumulation means for calculating and accumulating the issued points for more than two transactions. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 7, ll. 25-27; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows elements that suggest “point notification means for . . . notifying the customer of cumulative point information. . . .”

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows “customer identification means for identifying the customer according to customer identification information. . . .”

Schultz (col. 7, ll. 53-59; col. 5, ll. 45-56; and col. 6, ll. 1-13) discloses elements that suggest “wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions.”

Schultz lacks an explicit recitation of: “wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 7, ll. 53-59; col. 5, ll. 45-56; and col. 6, ll. 1-13) would have been selected in accordance with “wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions. . . .” because such selection would have provided

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means for the *"consumer . . . to make reward product . . . purchases at more than one retail store . . . and have the purchase credits combined. . . ."* (See Schultz (col. 7, ll. 53-59)).

**Schultz lacks an explicit recitation of "the customer accesses the accumulated points stored on the computer through a terminal."**

**Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; and col. 12, ll. 33-40) shows elements that impliedly suggest: "the customer accesses the accumulated points stored on the computer through a terminal."**

**Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).**

**Schultz lacks an explicit recitation of: "instantaneously notifying the customer. . . ."**

**Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 1, ll. 60-67; col. 4, ll. 27-35; col. 6, ll. 48-55; col. 9, ll. 28-37; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10,**

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ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; col. 12, ll. 12-26; and col. 12, ll. 33-40) shows: "instantaneously notifying the customer. . . ."

Small proposes "types of service" and instantaneous terminal notification modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the instantaneous "notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).**

Schultz (col. 10, ll. 43-53) discloses: *"manufacturers. . . can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer "interest."

Schultz (col. 5, ll. 12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets this

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disclosure as reasonably suggesting "a software service in exchange for an amount of the accumulated points. . . ."

Schultz (col. 9,11. 13-25) discloses: *"Through the status report 17 and the reward certificate ... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer... to continue to purchase the reward products... over an extended period. . . . "* The Examiner interprets this disclosure as reasonably suggesting "a period of time of providing the software service...."; furthermore, The Examiner interprets the above disclosures as reasonably suggesting "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service.... "

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service.... " even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.



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Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"); therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11.30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the

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customer's accumulated points and a period of time of providing the software service.... " because such a marketing program would have encouraged *"continued purchases of targeted products beyond the one-time incentive of prior coupon systems."* (See Schultz (col. 4,11.45-47)).

As per claim 66 Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a "point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows "point issue means for issuing the points to the customer according to transactions performed by the customer. . . ."

Schultz (col. 7, ll. 25-27) discloses "*accumulating sales data. . . .*" The Examiner interprets this disclosure as suggesting "point accumulation means. . . ."

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows "point accumulation means for calculating and accumulating the issued points for more than two transactions. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 7, ll. 25-27; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows elements that suggest "point notification means for . . . notifying the customer of cumulative point information. . . ."

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Schultz (col. 5, ll. 57-60) discloses: *“Once the purchase reward offers . . . are defined by the manufacturer . . . the central management firm . . . stores records of the purchase reward offers . . . in an offer file . . . residing in the data bank of the PMCS [program management computer system] The products that are the subject of the purchase reward offers . . . have associated Universal Product Codes (UPC), which are used to access the reward offer records in the offer file. . . . In the instance when a reward offer applies to several products, the UPC of each eligible product for the reward offer will access to the reward offer record to which the products apply. . . .”* The Examiner interprets this disclosure as suggesting “point storing means for storing point information comprising the issued points for each customer identification. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows “point notification means for notifying the customer of point information. . . .”

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows “customer identification means for identifying the customer according to customer identification. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows “wherein the point notification means notifies the customer of the point information before the customer carries out transactions. . . .”

Schultz (col. 7, ll. 53-59; col. 5, ll. 45-56; and col. 6, ll. 1-13) discloses elements that suggest “wherein the point issue means comprises rate management means for changing a

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point calculation rate according to each of the more than two transactions.”

Schultz lacks an explicit recitation of: “wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions.”

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 7, ll. 53-59; col. 5, ll. 45-56; and col. 6, ll. 1-13) would have been selected in accordance with “wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions. . . .” because such selection would have provided means for the “*consumer . . . to make reward product . . . purchases at more than one retail store . . . and have the purchase credits combined. . . .*” (See Schultz (col. 7, ll. 53-59)).

Schultz lacks an explicit recitation of “the customer accesses the accumulated points stored on the computer through a terminal.”

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; and col. 12, ll. 33-40) shows elements that impliedly suggest: “the customer accesses the accumulated points stored on the computer through a terminal.”

Small proposes “terminal notification” modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “terminal

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**notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).**

Schultz lacks an explicit recitation of: "instantaneously notifying the customer. . . ."

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 1, ll. 60-67; col. 4, ll. 27-35; col. 6, ll. 48-55; col. 9, ll. 28-37; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; col. 12, ll. 12-26; and col. 12, ll. 33-40) shows: "instantaneously notifying the customer. . . ."

Small proposes "types of service" and instantaneous terminal notification modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the instantaneous "notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10**

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USPQ2d 1843 (CAFC 1989).

Schultz (col. 10, 11. 43-53) discloses: *"manufacturers. . . can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer "interest."

Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets this disclosure as reasonably suggesting "a software service in exchange for an amount of the accumulated points. . . ."

Schultz (col. 9,11. 13-25) discloses: *"Through the status report 17 and the reward certificate ... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer... to continue to purchase the reward products... over an extended period. . . ."* The Examiner interprets this disclosure as reasonably suggesting "a period of time of providing the software service...."; furthermore, The Examiner interprets the above disclosures as reasonably suggesting "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points

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according to the customer's accumulated points and a period of time of providing the software service.... "

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service.... " even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"); therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to

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*"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11.30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service.... " because such a marketing program would have encouraged *"continued purchases of targeted products beyond the one-time incentive of prior coupon systems."* (See Schultz (col. 4,11.45-47)).

As per claim 67, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a "method for implementing a point management system in a store. . . ."

Schultz (the ABSTRACT) discloses *"member consumers. . . ."* The Examiner interprets this disclosure as suggesting "registering the customer. . . ."

Schultz (col. 4, ll. 62-67) shows elements that impliedly suggest "receiving a customer ID as entered by a customer . . . [and] determining whether the customer



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entering the customer ID is registered, and if not registering the customer if the customer[sic]. . . .”

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows elements that impliedly suggest “providing a point service to the customer if a request therefore is received from the customer.”

Schultz lacks an explicit recitation of “providing a point service to the customer if a request therefore is received from the customer.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) would have been selected in accordance with “providing a point service to the customer if a request therefore is received from the customer. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)).**

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Schultz (col. 10,11. 43-53) discloses: *"manufacturers ... can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer *"interest."*

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."*

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."*

Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets the above disclosures as reasonably suggesting *"issuing points to the customer according to transactions performed by the customer; calculating and accumulating the issued points for more than two transactions. . . ."* and *"providing a service including a software service in exchange for an amount of the accumulated*

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points. . . ." and adding interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "issuing points to the customer according to transactions performed by the customer; calculating and accumulating the issued points for more than two transactions. . . ." and "providing a service including a software service in exchange for an amount of the accumulated points. . . ." and adding interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10, 11. 43-53; col. 5, 11. 12-30; and col. 9, 11. 13-25) reasonably suggests same.

Small (col. 9, 11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "providing a service including a software service in exchange for an amount of the accumulated points.... " where the open-ended term "including" signals that "providing a service" or "a software service" or a "point service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9, 11. 30-37).

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Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11.30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "providing a service including a software service in exchange for an amount of the accumulated points, and adding interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service.... " because such a marketing program would have encouraged *"continued purchases of targeted products beyond the one-time incentive of prior coupon systems."* (See Schultz (col. 4,11.45-47)).

Schultz lacks an explicit recitation of "wherein the customer accesses the accumulated points stored on the computer through a terminal."

Small (FIG. 7 through FIG. 10; col. 1,11. 13-26; col. 1,11. 33-42; col. 6,11. 48-55; col. 9,11. 38-44; col. 9,11. 53-56; col. 10,11. 4-15; col. 11,11. 3-9; col. 11,11. 16-21; col. 11,11. 62-63; and col. 12,11. 33-40) shows: "wherein the customer accesses the accumulated points stored on the computer through a terminal."

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Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)).

As per claim 68, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (col. 4, ll. 5-16) shows "closing a transaction for a sale of a commodity with the customer."

Schultz lacks an explicit recitation of "closing a transaction for a sale of a commodity with the customer."

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 4, ll. 5-16) would have been selected in accordance with "closing a transaction for a sale of a commodity with the customer. . . ." based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided a *"method for encouraging continued purchases of targeted products. . . ."* (See Schultz (col. 4, ll. 44-50)).

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As per claim 69, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows “providing of the point service further comprises . . . displaying a number of present cumulative points of the customer.”

Schultz lacks an explicit recitation of “instantaneously displaying. . . .”

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 1, ll. 60-67; col. 4, ll. 27-35; col. 6, ll. 48-55; col. 9, ll. 28-37; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; col. 12, ll. 12-26; and col. 12, ll. 33-40) shows elements that suggest: “instantaneously displaying. . . .”

Small proposes instantaneous display modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the instantaneous display modifications of Small with the teachings of Schultz because such modifications would have provided a means to “*Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . .*” (See Small (col. 2, ll. 30-40)).

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As per claim 70, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows “wherein the providing of the point service further comprises displaying a plurality of point services; running one of the plurality of point services when requested by the customer. . . .”

Schultz (col. 7, ll. 25-27) discloses “*accumulating sales data. . . .*” The Examiner interprets this disclosure as suggesting “cumulative points. . . .”

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows “point accumulation means for calculating and accumulating the issued points for more than two transactions. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 7, ll. 25-27; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows elements that suggest “updating the number of present cumulative points. . . .”

Schultz lacks an explicit recitation of “updating the number of present cumulative points of the customer according to whether one of the plurality of point services is run.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) would have been selected in accordance with “updating the

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number of present cumulative points of the customer according to whether one of the plurality of point services is run. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.” (See Schultz (col. 4, ll. 50-55)).

As per claim 71, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows “wherein the providing of the point service further comprises displaying a point service information.”

Schultz lacks an explicit recitation of “displaying a point service information.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 5, ll. 55-68) would have been selected in accordance with “displaying a point service information. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.” (See Schultz (col. 4, ll. 50-55)).



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As per claim 72, Schultz in view of Small shows the method of claim 71. (See the rejection of claim 71 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows providing “point service information. . . .”

Schultz lacks an explicit recitation of “wherein the point service information is special days of the store, special days of the customer, service hours, service periods, or service areas.”

“Official Notice” is taken that both the concepts and the advantages of “wherein the point service information is special days of the store, special days of the customer, service hours, service periods, or service areas. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

As per claim 73, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 5, ll. 20-30 col. 6, ll. 1-4; and

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col. 6, ll. 10-12) shows “wherein the providing of the point service further comprises issuing points to the customer.”

Schultz lacks an explicit recitation of “wherein the providing of the point service further comprises issuing points to the customer.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 5, ll. 55-68; and col. 5, ll. 20-30) would have been selected in accordance with “wherein the providing of the point service further comprises issuing points to the customer. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

As per claim 74, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 5, ll. 20-30 col. 6, ll. 1-4; and col. 6, ll. 10-12) shows elements that impliedly suggest “wherein the providing of the point service further comprises accumulating points for the customer.”

Schultz lacks an explicit recitation of “wherein the providing of the point service further comprises accumulating points for the customer.”

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It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 5, ll. 55-68; and col. 5, ll. 20-30) would have been selected in accordance with “wherein the providing of the point service further comprises issuing points to the customer. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

As per claim 75, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 5, ll. 20-30 col. 6, ll. 1-4; and col. 6, ll. 10-12) shows elements that impliedly suggest “wherein the providing of the point service further comprises notifying the customer of a shortage of the customer’s cumulative points.”

Schultz lacks an explicit recitation of “wherein the providing of the point service further comprises notifying the customer of a shortage of the customer’s cumulative points.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (col. 5, ll. 55-68; and col. 5, ll. 20-30) would have been selected in accordance with “wherein the providing of the point service further

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comprises notifying the customer of a shortage of the customer's cumulative points. . . .”  
based upon the motivation to modify Schultz found in the Schultz reference itself, i.e.,  
because such selection would have provided means for “*a marketing program . . . [to  
reward] specific purchase behavior and [increase] consumer brand loyalty for  
manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

As per claim 76, Schultz in view of Small shows the method of claim 67. (See the  
rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll.  
5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 6, ll. 1-4; and col. 6, ll. 10-12)  
shows providing “point service information. . . .”

Schultz (col. 5, ll. 57-60) discloses: “*The purchase reward offers . . . can include  
standard rebates, trial rebates, gift offers, and sweepstakes offers.*”

Schultz (FIG. 2) shows “*REBATE*” means. The Examiner interprets “rebate”  
means as suggesting exchanging money for cumulative points of the customer.”

Schultz lacks an explicit recitation of “wherein the providing of the point service  
further comprises exchanging money for cumulative points of the customer.”

It would have been obvious to a person of ordinary skill in the art at the time of the  
invention that the disclosure of Schultz (FIG. 2; and col. 5, ll. 57-60), i.e., “*REBATE*”  
means would have been selected in accordance with “wherein the providing of the point  
service further comprises exchanging money for cumulative points of the customer. . . .”  
based upon the motivation to modify Schultz found in the Schultz reference itself, i.e.,

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because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

As per claim 77, Schultz in view of Small shows the method of claim 67. (See the rejection of claim 67 supra).

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 55-68; col. 5, ll. 20-30 col. 6, ll. 1-4; and col. 6, ll. 10-12) shows elements that impliedly suggest “managing a customer database.”

Schultz (FIG. 1) shows “*CONSUMER HISTORY RECORDS.*”

Schultz (FIG. 2) shows “*CUSTOMER FILES.*”

Schultz lacks an explicit recitation of “managing a customer database.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (FIG. 1; and FIG. 2) would have been selected in accordance with “managing a customer database. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

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9. Independent claims 28, 50 & 52 and dependent claims 29 & 53 are rejected under 35

U.S.C. §103(a) as being unpatentable over Schultz in view of Burton et al. 5,025,372

(6/18/1991) (herein referred to as “Burton”) and further in view of Small.

As per claim 28, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a “point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows a “point issue means for issuing the points to the customer according to transactions performed by the customer. . . .”

Schultz (col. 7, ll. 25-27) discloses “*accumulating sales data. . . .*” The Examiner interprets this disclosure as suggesting “point accumulation means. . . .”

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows a “point accumulation means for calculating and accumulating the issued points. . . .”

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows “customer identification means for identifying the customer according to customer identification information. . . .”

Schultz lacks explicit mention of “a software service in exchange for an amount of the accumulated points, and the point accumulation means decreases the customer’s accumulated points according to a period of time of providing the software service. . . .”

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Burton (col. 19, ll. 9-68; col. 20, ll. 1-68; col. 21, ll. 46-68; col. 22, ll. 38-68; col. 23, ll. 4-68) shows elements that suggest “wherein the point management system provides a software service in exchange for an amount of the accumulated points. . . .”

Burton (FIG. 2.8A; FIG. 2.8B; col. 9, ll. 50-68; col. 10, ll. 1-7; col. 10, ll. 44-51; col. 28, ll. 16-35; and col. 28, ll. 60-68) shows elements that suggest “wherein the point management system provides a service including a software service in exchange for an amount of the accumulated points, and the point accumulation means decreases the customer’s accumulated points according to a period of time of providing the software service. . . .”

Burton proposes software program and credit decreasing modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the credit decreasing modifications of Burton with the teachings of Schultz because “*the participants can choose to withhold none, part, or all of the monetary amount eligible for allocation toward the credit. . . .*” (See Burton (col. 4, ll.16-19)).

Schultz lacks an explicit recitation of “the customer accesses the accumulated points stored on the computer through a terminal.”

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; and col. 12, ll. 33-40) shows: “the customer accesses the accumulated points stored on the computer through a terminal.”

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Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."* The Examiner interprets this disclosure as reasonably suggesting "a period of time of providing the software service. . . ."; furthermore, The Examiner interprets the above disclosures as reasonably suggesting "wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software



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service. . . ." even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)). And

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**it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with “wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . .” because such a marketing program would have encouraged *“continued purchases of targeted products beyond the one-time incentive of prior coupon systems. ”* (See Schultz (col. 4,11.45-47)).**

As per claim 29, Schultz in view of Burton and Small shows the point management system of claim 28. (See the rejection of claim 28 supra).

Schultz lacks an explicit recitation of “the software service is provided to the customer with image and voice data through communication circuits . . . displays the decreased points on a display by denoting an alphanumeric number representing the customer's accumulated points and by counting down the customer's accumulated points order. . . .”

Small (col. 9, ll. 38-44; FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; and

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col. 11, ll. 62-63) shows: “the software service is provided to the customer with image and voice data through communication circuits . . . displays the decreased points on a display by denoting an alphanumeric number representing the customer’s accumulated points and by counting down the customer’s accumulated points order. . . .”

Small proposes “terminal notification” modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “terminal notification” modifications of Small with the teachings of Schultz because such modifications would have provided a means to *“Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . .”* (See Small (col. 2, ll. 30-40)).

As per claim 50 Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a “point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . .”

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows “point issue means for issuing the points to the customer according to transactions performed by the customer. . . .”

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Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows “point notification means for . . . notifying the customer of . . . point information comprising the issued points. . . .”

Schultz (col. 7, ll. 25-27) discloses “*accumulating sales data. . . .*” The Examiner interprets this disclosure as suggesting “point accumulation means. . . .”

Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows “point accumulation means for calculating and accumulating the issued points. . . .”

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows “customer identification means for identifying the customer according to customer identification information. . . .”

Schultz (col. 8, ll. 30-63) discloses “*customer service support. . . .*” and elements that suggest “types of services. . . .”

Schultz (col. 5, ll. 57-60) discloses: “*The purchase reward offers . . . can include standard rebates, trial rebates, gift offers, and sweepstakes offers.*”

Schultz (col. 5, ll. 57-60) discloses: “*Once the purchase reward offers . . . are defined by the manufacturer . . . the central management firm . . . stores records of the purchase reward offers . . . in an offer file . . . residing in the data bank of the PMCS*

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[program management computer system] *The products that are the subject of the purchase reward offers . . . have associated Universal Product Codes (UPC), which are used to access the reward offer records in the offer file. . . . In the instance when a reward offer applies to several products, the UPC of each eligible product for the reward offer will access to the reward offer record to which the products apply. . . .*” The Examiner interprets this disclosure as suggesting “wherein the point notification means comprises service contents storage means for storing a list of types of services and corresponding points. . . .”

Schultz (col. 6, ll. 5-12; and col. 7, ll. 60-68) discloses “*the manufacturer can offer an entry into a sweepstakes drawing for each product purchase. . . .*” The Examiner interprets this disclosure as suggesting “wherein the point notification means comprises service contents storage means for storing a list of types of services and corresponding points. . . .”

Schultz (col. 9, ll. 30-38; col. 9, ll. 47- 59; col. 10, ll. 7-35; col. 7, ll. 5-10; col. 7, ll. 20-59; col. 9, ll. 1-2; and col. 9, ll. 60-65) shows elements that suggest “notification means . . . displays . . . the list of the types of services and corresponding points to the customer. . . .”

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Schultz does not explicitly show “types of services. . . .”

Burton (col. 1, ll. 10-20) discloses: “*The invention relates to the field of computer programming and data processing systems for incentive award programs [sic] Heretofore incentive companies have contracted with a sponsoring company for providing an incentive program to promote the sales of the sponsoring company’s products or services. . . . The products or services promoted might have been of a specific nature. . . .*”

Burton (col. 1, ll. 17-20) discloses: “*Usually a certain number of points are awarded . . . [related to the] quantity of products or services.*”

Burton proposes “types of services” modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “services” modifications of Burton with the teachings of Schultz because “*the participant’s memory of the . . . [services] stimulates recollection of the sponsor, thus reinforcing favorable thoughts toward the sponsor.*” (See Burton (col. 3, ll. 67-68; and col. 4, ll. 1-2)).

Schultz lacks an explicit recital of: “displays on a terminal the list of . . . points. . . .”

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 6, ll. 48-55; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11,

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ll. 62-63; and col. 12, ll. 33-40) shows elements that impliedly suggest the explicit

recitation: "displays on a terminal the list of . . . points. . . ."

Small proposes "terminal display" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, ll. 30-40)).

**Schultz lacks an explicit recitation of "the customer accesses the accumulated points stored on the computer through a terminal."**

**Small (FIG. 7 through FIG. 10; col. 1,11. 13-26; col. 1,11. 33-42; col. 6,11. 48-55; col. 9,11. 38-44; col. 9,11. 53-56; col. 10,11. 4-15; col. 11,11. 3-9; col. 11,11. 16-21; col. 11,11. 62-63; and col. 12,11. 33-40) shows elements that impliedly suggest: "the customer accesses the accumulated points stored on the computer through a terminal."**

**Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal**

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**notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)).**

Schultz lacks an explicit recital of: "instantaneously notifying the customer of cumulative point information. . . ." and "wherein a number of the customer's cumulative points may be redeemed for a number of the types of services."

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 1, ll. 60-67; col. 4, ll. 27-35; col. 6, ll. 48-55; col. 9, ll. 28-37; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; col. 12, ll. 12-26; and col. 12, ll. 33-40) shows elements that suggest: "instantaneously notifying the customer of cumulative point information. . . ." and "wherein a number of the customer's cumulative points may be redeemed for a number of the types of services."

Small proposes "types of service" and instantaneous terminal notification modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote*



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*interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . .” (See Small (col. 2, ll. 30-40)).*

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).**

**Schultz (col. 10,11. 43-53) discloses: “*manufacturers ... can increase consumer loyalty through the marketing method of the present invention.*” The Examiner interprets “*consumer loyalty*” as consumer “*interest*.”**

**Schultz (col. 5,11.12-30) discloses: “*In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned.*” The Examiner interprets this disclosure as reasonably suggesting “a software service in exchange for an amount of the accumulated points. . . .”**

**Schultz (col. 9,11.13-25) discloses: “*Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the***

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*purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . .*" The Examiner interprets this disclosure as reasonably suggesting "a period of time of providing the software service. . . ."; furthermore, The Examiner interprets the above disclosures as reasonably suggesting "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: "*In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . .*" The Examiner

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interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a

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**service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." because such a marketing program would have encouraged "*continued purchases of targeted products beyond the one-time incentive of prior coupon systems.* " (See Schultz (col. 4,11.45-47)).**

As per claim 52, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows a "point management system employing a computer for managing points issued to each customer who receives service according to the issued points. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 ) shows "point issue means for issuing the points to the customer according to transactions performed by the customer. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows elements that suggest "point notification means for . . . notifying the customer of **cumulative** point information comprising the issued points. . . ."

Schultz (col. 7, ll. 25-27) discloses "*accumulating sales data. . . .*" The Examiner interprets this disclosure as suggesting "point accumulation means. . . ."

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Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 40-65; col. 7, ll. 25-27; col. 7, ll. 35-44; col. 8, ll. 1-6; col. 6, ll. 6-10; col. 5, ll. 15-20; **col. 5, ll. 45-53; and col. 4, ll. 56-60**) shows “point accumulation means for calculating and accumulating the issued points. . . .”

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows elements that suggest “customer identification means for identifying the customer according to customer identification information. . . .”

Schultz (col. 8, ll. 30-63) discloses “*customer service support. . . .*” and elements that suggest “types of services. . . .”

Schultz (col. 5, ll. 57-60) discloses: “*The purchase reward offers . . . can include standard rebates, trial rebates, gift offers, and sweepstakes offers.*”

Schultz (col. 5, ll. 57-60) discloses: “*Once the purchase reward offers . . . are defined by the manufacturer . . . the central management firm . . . stores records of the purchase reward offers . . . in an offer file . . . residing in the data bank of the PMCS [program management computer system] The products that are the subject of the purchase reward offers . . . have associated Universal Product Codes (UPC), which are used to access the reward offer records in the offer file. . . . In the instance when a reward offer applies to several products, the UPC of each eligible product for the reward offer will access to the reward offer record to which the products apply. . . .*” The Examiner interprets **these above disclosures** as suggesting “wherein the point notification means further comprises service contents storage means for selecting a range

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1 of services available in exchange for the accumulated points of the customer, and . . .

2 notifies the customer of the selected services. . . .”

3 Schultz (col. 9, ll. 30-38; col. 9, ll. 47- 59; col. 10, ll. 7-35; col. 7, ll. 5-10; col. 7, ll.

4 20-59; col. 9, ll. 1-2; and col. 9, ll. 60-65) shows “notification means . . . selects a range

5 of services available for the accumulated points of the customer, and . . . notifies the

6 customer of the selected services. . . .”

7 Schultz does not explicitly recite “selecting a range of services. . . .” even though

8 Schultz (col. 9, ll. 30-38; col. 9, ll. 47- 59; col. 10, ll. 7-35; col. 7, ll. 5-10; col. 7, ll. 20-

9 59; col. 9, ll. 1-2; and col. 9, ll. 60-65) suggests same.

Burton (col. 1, ll. 10-20) discloses: “*The invention relates to the field of computer programming and data processing systems for incentive award programs [sic]*

*Heretofore incentive companies have contracted with a sponsoring company for*

*providing an incentive program to promote the sales of the sponsoring company’s*

*products or services. . . . The products or services promoted might have been of a specific nature. . . .”*

Burton (col. 1, ll. 17-20) discloses: “*Usually a certain number of points are awarded . . . [related to the] quantity of products or services.*”

Burton proposes “**range of services**” modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “**range of services**” modifications of Burton with the teachings of Schultz because “*the participant’s memory of the . . .*

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[services] *stimulates recollection of the sponsor, thus reinforcing favorable thoughts toward the sponsor.*” (See Burton (col. 3, ll. 67-68; and col. 4, ll. 1-2)).

Schultz lacks an explicit recital of: “instantaneously notifies the customer . . . through a terminal.”

Small (FIG. 7 through FIG. 10; col. 1, ll. 13-26; col. 1, ll. 33-42; col. 1, ll. 60-67; col. 4, ll. 27-35; col. 6, ll. 48-55; col. 9, ll. 28-37; col. 9, ll. 38-44; col. 9, ll. 53-56; col. 10, ll. 4-15; col. 11, ll. 3-9; col. 11, ll. 16-21; col. 11, ll. 62-63; col. 12, ll. 12-26; and col. 12, ll. 33-40) shows elements that impliedly suggest: “instantaneously notifies the customer . . . through a terminal.”

Small proposes instantaneous terminal notification modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the “terminal notification” modifications of Small with the teachings of Schultz because such modifications would have provided a means to “*Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . .*” (See Small (col. 2, ll. 30-40)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)).**

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**Schultz** (col. 10,11. 43-53) discloses: *"manufacturers ... can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer *"interest."*

**Schultz** (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets this disclosure as reasonably suggesting "a software service in exchange for an amount of the accumulated points. . . ."

**Schultz** (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."* The Examiner interprets this disclosure as reasonably suggesting "a period of time of providing the software service. . . ."; furthermore, The Examiner interprets the above disclosures as reasonably suggesting "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the



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customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

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Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." because such a marketing program would have encouraged *"continued purchases of targeted products beyond the one-time incentive of prior coupon systems. "* (See Schultz (col. 4,11.45-47)).

Schultz lacks an explicit recitation of "the customer accesses the accumulated points stored on the computer through a terminal."

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Small (FIG. 7 through FIG. 10; col. 1,11. 13-26; col. 1,11. 33-42; col. 6,11. 48-55; col. 9,11. 38-44; col. 9,11. 53-56; col. 10,11. 4-15; col. 11,11. 3-9; col. 11, 11. 16-21; col. 11, 11. 62-63; and col. 12,11. 33-40) shows: "the customer accesses the accumulated points stored on the computer through a terminal."

Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2, 11. 30-40)).

As per claim 53, Schultz in view of Burton and further in view of Small shows the point management system of claim 52. (See the rejection of claim 52 supra).

Schultz does not explicitly recite: "wherein the service contents storage means stores the point information comprising target points for a service requested by the customer, the customer's accumulated points, and shortage points relative to the customer's target."

Burton (col. 9, ll. 50-68) discloses *"objective for the incentive program's participants. . . ."* The Examiner interprets this disclosure as suggesting "target points."

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Burton (FIG. 2.8A; FIG. 2.8B; col. 9, ll. 50-68; col. 10, ll. 1-7; col. 10, ll. 44-51; col. 28, ll. 16-35; and col. 28, ll. 60-68) shows elements that suggest “wherein the service contents storage means stores the point information comprising target points for a service requested by the customer, the customer’s accumulated points, and shortage points relative to the customer’s target.”

Burton proposes incentive objective modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the incentive objective modifications of Burton with the teachings of Schultz because “*the participants can choose to withhold none, part, or all of the monetary amount eligible for allocation toward the credit. . . .*” (See Burton (col. 4, ll.16-19)).

### RESPONSE TO ARGUMENTS

10. Applicant's arguments filed 03/17/2003 ( Amendment J, paper# 49) have been fully considered but they are not persuasive for the following reasons:

Applicant’s argument (Amendment J, paper#49, p. 8, ll. 1-32; and p. 9, ll. 1-24) alleges that “claims 24-26, 28, 50, 52, and 65-66 recite that the ‘point management system provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer’s accumulated points according to the customer’s accumulated points and a period of time of providing the software service, and wherein the customer accesses the

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accumulated points stored on the computer through a terminal.’ None of the cited references discloses or suggests the same.”

This is not the case.

New grounds of rejection necessitated by Applicant’s amendments to the claims renders Applicant’s argument moot. Furthermore, Applicant’s arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant’s argument (Amendment J, paper#49, p. 9, ll. 25-30; and p. 10, ll. 1-2) alleges that the “Examiner is using an old, outdated standard [to support motivation for combining the references].” This is not the case.

It is well settled in the law that “It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . .” (See MPEP 2144 RATIONAL DIFFERENT FROM APPLICANT’S IS PERMISSIBLE (August 2001) p. 2100-127); furthermore,

It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See

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*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); and

It is well settled in the law that the Examiner must point to some concrete evidence in the reference in support of his findings. (See *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In this case, and throughout the prior office actions and in the rejections supra the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the Examiner has detailed with particularity concrete evidence by citing from the references where the features of the claims are suggested in the prior art references and citing from the references where there are teachings in the references to modify and/or combine the references to derive the present invention; thereby explaining the reasons that one of ordinary skill in the art would have been motivated to combine the references; furthermore, notwithstanding Applicant's argument, "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP 2144 RATIONAL DIFFERENT FROM APPLICANT'S IS PERMISSIBLE (August 2001) p. 2100-127).

Applicant's argument (Amendment J, paper#49, p. 10, ll. 3-18) alleges that the "words 'instantaneously,' 'immediately,' and 'instant' appear in Small in contexts completely unrelated to notification of point information." This is not the case.

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It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

In this case Schultz (col. 4, ll. 55-65) discloses: “*Manufacturers . . . provide incentive rewards for purchases of . . . their products. The purchase incentives are compiled . . . distributed . . . directly to consumers. . . .*” The Examiner interprets this disclosure as “point notification means for . . . notifying the customer of the cumulative point information. . . .” However, even though Schultz lacks explicit recitation of “instantaneously notifying,” Small (col. 4, ll. 27-35) discloses: “*if . . . awards are given . . . the sweepstakes may . . . instantaneously credit the winner’s . . . account. . . .*” The Examiner interprets the disclosure of Schultz in view of the disclosure of Small as suggesting “point notification means for instantaneously notifying the customer of the cumulative point information. . . .” Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the instantaneous notification elements of the instant invention (i.e., claims 50, 52, 65 & 66 [claims 17 & 18 are canceled]) read on the combined prior art references of record.

In response to Applicant’s argument (Amendment J, paper#49, p. 10, ll. 19-22) which asserts “that claims 17 & 18 recite that a number of the customer’s cumulative points may be redeemed. . . .”, Applicant’s arguments are moot because claims 17 & 18 are canceled by Applicant.

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Applicant's argument (Amendment J, paper#49, p. 10, ll. 19-25; and p. 11, ll. 1-30) alleges "that [claim] 50 recite[s] that a number of the customer's cumulative points may be redeemed. For a number of the types of services and that claims 28 and 52 recite that a service is provided in exchange for an amount of accumulated pints. The Applicant's argued that 'none of Shultz [sic], Burton, or Small discloses or suggests that the 'types of services' refer to services that are provided to the customer upon redemption of points.'" This is not the case.

It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

In this case, Small (col. 6, ll. 48-55) discloses "*user indicia. . . .*" In this case, the Examiner interprets "*user indicia. . . .*" as "points" for "redemption."

Small (col. 9, ll. 28-37) discloses "*the prize is a material good or service. . . . a . . . coupon for use at a . . . store.*" In this case, The Examiner interprets the "coupon" is used for "redemption" of *a material good or service.*"

Small (col. 10, ll. 4-15) discloses "*user indicia specific to the user and game. . . . [are compared] . . . and determines whether a programmed winning correlation exists between them.*" In this case, the Examiner interprets the indicia as "points" for "redemption."



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Small (col. 11, ll. 62-63) discloses “*tracking the purchase of . . . chances. . . .*”

The Examiner interprets these disclosures as reasonably suggesting “wherein a number of the customer’s cumulative points may be redeemed for a number of the types of services.”

Therefore, it would have been obvious to a person or ordinary skill in the art at the time of the invention that the “wherein a number of the customer’s cumulative points may be redeemed for a number of the types of services elements and limitations of the instant invention (i.e., claims 50, 28 & 52) read on the combined prior art references of record.

Applicant’s argument (Amendment J, paper#49, p. 11, ll. 12-15) which asserts “[when] neither the primary nor secondary reference discloses or suggests an elements[sic] of the claimed invention, the rejection is insufficient to render the claimed invention obvious. . . .” and “the references cannot be combined, as they teach away from one another . . . .”

It is well settled in the law that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. (See *In re Susi*, 169 USPQ 423 (CCPA 1971).

It is also well settled that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would

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have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the references teach away, and Applicant's arguments fail to cite any relevant precedent to support the allegation that "the rejection is insufficient to render the claimed invention obvious."

In response to Applicant's argument (Amendment J, paper#49, p. 12, ll. 1-5) which asserts "The Examiner did not directly address the Applicants' arguments in regard to claims 24-26 and 28. . . . [in the prior Office Action], please note the following:

As per claim 28, in response to Applicant's argument (Amendment I; paper#46, p. 10), that "none of Schultz, Burton, or Small discloses or suggests "types of services' refer to services that are provided to the customer upon redemption of points. . . .", Applicant's attention is directed to Small (col. 9, ll. 28-37) which suggests "types of services. . . ."; furthermore:

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).**

**Schultz (col. 10,11. 43-53) discloses: "*manufacturers ... can increase consumer loyalty through the marketing method of the present invention.*" The Examiner interprets "*consumer loyalty*" as consumer "*interest*."**

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Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets this disclosure as reasonably suggesting "a software service in exchange for an amount of the accumulated points. . . ."

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."* The Examiner interprets this disclosure as reasonably suggesting "a period of time of providing the software service. . . ."; furthermore, The Examiner interprets the above disclosures as reasonably suggesting "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points

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to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) reasonably suggests same.

Small (col. 9,11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined. . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "the point management system provides a service including a software service. . . ." where the open-ended term "including" signals that "the point management system provides a service" or "a software service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9,11. 30-37).

Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-*

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*specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . .” (See Small (col. 2,11. 30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5, 11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "wherein the point management systems provides a service including a software service in exchange for an amount of the accumulated points, wherein the point accumulation means adds interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." because such a marketing program would have encouraged "*continued purchases of targeted products beyond the one-time incentive of prior coupon systems.* " (See Schultz (col. 4,11.45-47)).*

Applicant's argument (Amendment I; paper#46, p. 11, ll. 7-33; p. 12, ll. 1-14; and p. 12, ll. 25-28) which alleges that "claims 24-26, and 28 of the subject application . . . recite the customer accessing the 'accumulated points' stored of the computer through a terminal. In contrast, none of Schultz, Burton, Humble, or Small discloses or suggests the customer accessing the 'accumulated points' stored on the computer through a terminal. . . ." and "the Examiner fails to point to some concrete evidence in the reference in support of his findings."

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It is also well settled that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the combined teachings of the references would have suggested all of the elements and limitations of the claims in the instant application. (See the rejection of claims 24-26 & 28 supra).

Also, it is well settled in the law that the Examiner must point to some concrete evidence in the reference in support of his findings. (See *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In this case, and throughout the prior office actions and in the rejections supra the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the Examiner has detailed with particularity concrete evidence by citing from the references where the features of the claims are suggested in the prior art references and citing from the references where there are teachings in the references to modify and/or combine the references to derive the present invention; thereby explaining the reasons that one of ordinary skill in the art would have been motivated to combine the references; furthermore, notwithstanding Applicant's argument, "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP

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2144 RATIONAL DIFFERENT FROM APPLICANT'S IS PERMISSIBLE (August 2001) p. 2100-127). (See the obviousness rejections of claims 24-26 & 28 supra).

Applicant's argument (Amendment J, paper#49, p. 12, ll. 6-25) alleges that the prior Office Action does not properly support the obviousness rejection of claim 67 because the prior Office Action does not provide concrete evidence in the reference in support of the findings of obviousness.

This is not the case.

It is well settled in the law that the Examiner must point to some concrete evidence in the reference in support of his findings. (See *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In this case, and throughout the prior office actions and in the rejections supra the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the Examiner has detailed with particularity concrete evidence by citing from the references where the features of the claims are suggested in the prior art references and citing from the references where there are teachings in the references to modify and/or combine the references to derive the present invention; thereby explaining the reasons that one of ordinary skill in the art would have been motivated to combine the references; furthermore, notwithstanding Applicant's argument, "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP

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2144 RATIONAL DIFFERENT FROM APPLICANT'S IS PERMISSIBLE (August 2001) p. 2100-127). (See the excerpt of the obviousness rejection of claim 67 infra):

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) shows elements that impliedly suggest “providing a point service to the customer if a request therefore is received from the customer.”

Schultz lacks an explicit recitation of “providing a point service to the customer if a request therefore is received from the customer.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-25; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; and col. 6, ll. 10-12) would have been selected in accordance with “providing a point service to the customer if a request therefore is received from the customer. . . .” based upon the motivation to modify Schultz found in the Schultz reference itself, i.e., because such selection would have provided means for “*a marketing program . . . [to reward] specific purchase behavior and [increase] consumer brand loyalty for manufacturers who participate in the program.*” (See Schultz (col. 4, ll. 50-55)).

**It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).**



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Schultz (col. 10,11. 43-53) discloses: *"manufacturers ... can increase consumer loyalty through the marketing method of the present invention."* The Examiner interprets *"consumer loyalty"* as consumer *"interest."*

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."*

Schultz (col. 9,11.13-25) discloses: *"Through the status report 17 and the reward certificate... the marketing program of the present invention completely automates the purchase reward system from the consumer viewpoint and creates a convenient inducement for the consumer . . . to continue to purchase the reward products . . . over an extended period. . . ."*

Schultz (col. 5,11.12-30) discloses: *"In the program management computer system, the consumer identified purchase information is compared to the offer descriptions of the participating products and recorded for each consumer. Each consumer is sent a periodic summary of all his purchases of the participating products and a reward certificate for the rewards earned."* The Examiner interprets the above disclosures as reasonably suggesting *"issuing points to the customer according to transactions performed by the customer; calculating and accumulating the issued points for more than two transactions. . . ."* and *"providing a service including a software service in exchange for an amount of the accumulated*

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points. . . ." and adding interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ."

Schultz lacks an explicit recitation of "issuing points to the customer according to transactions performed by the customer; calculating and accumulating the issued points for more than two transactions. . . ." and "providing a service including a software service in exchange for an amount of the accumulated points. . . ." and adding interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service. . . ." even though Schultz (col. 10, 11. 43-53; col. 5, 11. 12-30; and col. 9, 11. 13-25) reasonably suggests same.

Small (col. 9, 11. 30-37) discloses: *"In the event the prize is a material good or service, an appropriate manner of awarding same is determined . . ."* The Examiner interprets this disclosure of Small in view of the overly broad claim language of claim 24 (i.e., "providing a service including a software service in exchange for an amount of the accumulated points.... " where the open-ended term "including" signals that "providing a service" or "a software service" or a "point service" or any other kind of "service"; therefore, the broad wording of the service element of the instant invention reads on the above disclosures of Schultz in view of Small (col. 9, 11. 30-37).

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Small proposes awarding "services" modifications that would have applied to the system of Schultz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Small with the disclosure of Schultz because such combination would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11.30-40)). And it would have been obvious to a person of ordinary skill in the art at the time of the invention that the above disclosures of Schultz (col. 10,11. 43-53; col. 5,11. 12-30; and col. 9,11. 13-25) in view of Small (col. 2,11. 30-40) would have been selected in accordance with "providing a service including a software service in exchange for an amount of the accumulated points, and adding interest points to the customer's accumulated points according to the customer's accumulated points and a period of time of providing the software service.... " because such a marketing program would have encouraged *"continued purchases of targeted products beyond the one-time incentive of prior coupon systems."* (See Schultz (col. 4,11.45-47)).

Schultz lacks an explicit recitation of "wherein the customer accesses the accumulated points stored on the computer through a terminal."

Small (FIG. 7 through FIG. 10; col. 1,11. 13-26; col. 1,11. 33-42; col. 6,11. 48-55; col. 9,11. 38-44; col. 9,11. 53-56; col. 10,11. 4-15; col. 11,11. 3-9; col. 11,11. 16-21; col. 11,11. 62-63; and col. 12,11. 33-40) shows: "wherein the customer accesses the accumulated points stored on the computer through a terminal."

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**Small proposes "terminal notification" modifications that would have applied to the award system and method of Schultz. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the "terminal notification" modifications of Small with the teachings of Schultz because such modifications would have provided a means to *"Identify a user of a remote interface device and assign a user-specific indicia thereto for matching to a randomly selected game indicia to determine whether the user wins a prize. . . ."* (See Small (col. 2,11. 30-40)).**

Applicant's argument (Amendment J, paper#49, p. 12, ll. 26-28; and p. 13, ll. 1-2) alleges that the pending claims of the instant application are allowable amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

**NOTE: As per claim 72, the Official Notice evidence was not seasonably challenged in a prior response by Applicant; therefore said evidence is deemed admitted.**

It is well settled that "Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. . . . A challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice. . . . If [A]pplicant does not seasonably traverse the well known statement during examination,

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then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). **A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution.** Thus, [A]pplicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made ” (See MPEP 2144.03 Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art 8 ed., August 2001, pp. 2100-129 and 2100-130).

**In this instance, Applicant’s Response (Amendment J, paper#49) fails to demand a reference in support of the Official Notice evidence cited by the Examiner in the prior Office action concerning the obviousness rejection of claim 72. And, Applicant’s Response lacks adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice and thereby fails to seasonably challenge the Official Notice rejections of the instant invention.**

#### **ACTION MADE FINAL**

**Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not**

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**mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.**

### **CONCLUSION**

11. Any response to this action should be mailed to:

Commissioner for Patents  
AF  
P. O. Box 1450  
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

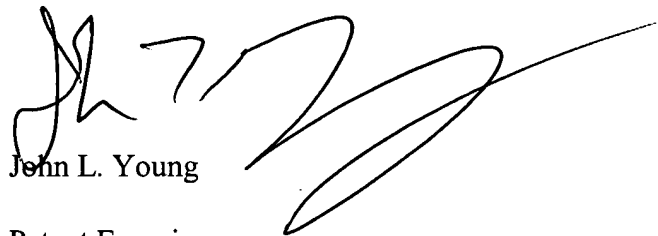
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The

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examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'John L. Young', is written over the printed name. The signature is stylized with a large, sweeping loop at the end.

John L. Young

Patent Examiner

May 22, 2003